UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,550	04/26/2001	Raymond S. Bamford	ENSY-004	9238

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GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

EXAMINER
ROBINSON BOYCE, AKIBA K

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/843,550	BAMFORD ET AL.
	Examiner	Art Unit	
	Akiba K. Robinson-Boyce	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>01 September 2006</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-25</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   In view of the **Appeal Brief** filed on **9/1/06**, PROSECUTION IS HEREBY

REOPENED. **A new ground of rejection is** set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an

appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal

brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37

CFR 41.20 have been increased since they were previously paid, then appellant must

pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by

signing below:

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Status of Claims

2.   Due to communications filed 9/1/06, the following is a non-final office action.

Prosecution for this case has been re-opened. Claims 1-25 are pending in this

application, have been examined on the merits, and are rejected as follows.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kopelman et al (US 2004/0138966 A1).

As for Claim 1, Kopelman et al discloses a method comprising:

receiving the electronic price request from the buyer, ([0038]-[0039], buyer

expresses interest in buying the good, for example clicking a checkbox on a web site,

and the marketeer then presents the good at a sale price, in this case, since the price is

unknown prior to the clicking of the box on the website, and the price is presented

afterwards, this "clicking" [by way of computer] represents the electronic price request);

in response to the electronic price request, performing a computer-executed act

of determining whether title to the goods passes directly from the manufacturer to

the buyer or through an intermediate e-market place, ([0040], upon facilitating the sale

transaction between the buyer and seller, it can be done through referral to an

intermediary clearinghouse, or the escrow agent himself may itself act as the

intermediary, also see [0043], lines 1-4, shows that goods in addition to those listed or

registered for sale by sellers at a marketeer's website in an e-market environment are

also presented by the marketer for browsing by a buyer);

Providing the buyer with a machine-readable signal for displaying the computed

price, ([0039], transmitting data for displaying the sale price of the good).

The following is obvious with Kopelman et al since settlements occur at a

clearinghouse, and prices need to be computed/determined in order to settle. Also,

since the title for the goods do not need to pass through the e-market when a buyer

directly goes through the manufacturer, the computed price would differ:

computing a price of the goods to the buyer based at least partially on the

determining act.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to compute a price of the goods to the buyer based at least

partially on the determining act with the motivation of determining the price according to

the method in which goods are accessed.

As for Claim 2, Kopelman et al further discloses the method wherein a first

pricing regime is implemented when it is determined that title to the goods passes

directly from the manufacturer to the buyer ([0040], escrow agent himself may itself act

as the intermediary, it is inherent that a first price regime will be implemented since the

regime is different than the regime used if the transaction went through an intermediary

clearinghouse, also see [0043], where the manufacturer/marketeer has goods of his

own for sale, it is inherent that a first price regime will be implemented since the regime

is different than the regime used if the transaction went through goods registered by

other sellers on the manufacturer's/marketeer's website).

As for Claim 3, Kopelman et al further discloses the method, wherein when it is

determined that title passes through an intermediate e-market place, the method further includes determining whether to implement the first pricing regime or a second pricing regime ([0040], upon facilitating the sale transaction between the buyer and seller, it can be done through referral to an intermediary clearinghouse, and is inherent to determine which pricing regime should be implemented since the transaction can also go through the escrow agent himself, which implements a different, or a second pricing regime, also see [0043], where a sales transaction can also occur through the e-market, and in this case, it is inherent to determine which pricing regime should be implemented since the transaction can also go through the manufacturer/marketer himself, which implements a different, or a second pricing regime).

As for Claim 4, Kopelman et al further discloses the method including the step of determining whether to discount a price ([0028], lines 1-8, discount).

As for Claim 5, Kopelman et al further discloses the method, wherein a discount is determined based on volume of a current order ([0028], lines 6-11, discount is determined based on whether book is used or paperback).

As for Claim 6, Kopelman et al does not specifically disclose the following:

further discloses the method, wherein a discount is determined based on: a stocking/handling charge;

But does disclose that in retail type sales on online websites, an inventory of goods is maintained, and when maintaining inventory, it is common to include a stocking/handling charge in the inventory art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine a discount based in a stocking/handling charge with the motivation of allowing a reduced fee of an inventory of goods.

As for Claim 7, Kopelman et al further discloses the method including the step of determining whether to customize the price ([0040], upon facilitating the sale transaction between the buyer and seller, the marketeer may refer the parties to an intermediary clearinghouse, or the escrow agent may itself act a s the intermediary).

As for Claim 8, Kopelman et al further discloses the method, wherein the price is customized based on: geographic region, customer information, product line information, *manufacturer information* ([0040], upon facilitating the sale transaction between the buyer and seller, the marketeer may refer the parties to an intermediary clearinghouse, or the escrow agent may itself act a s the intermediary).

As Claim 9, Kopelman et al discloses a computer having logic programmable to execute method acts, method acts comprising:

receiving the electronic request form the buyer, ([0038]-[0039], buyer expresses interest in buying the good, for example clicking a checkbox on a web site, and the marketeer then presents the good at a sale price, in this case, since the price is unknown prior to the clicking of the box on the website, and the price is presented afterwards, this "clicking" [by way of computer] represents the electronic price request);

in response to the electronic request, determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place ([0040], upon facilitating the sale transaction between the buyer and seller, it can be

done through referral to an intermediary clearinghouse, or the escrow agent himself

may itself act as the intermediary, also see [0043], lines 1-4, shows that goods in

addition to those listed or registered for sale by sellers at a marketeer's website in an e-

market environment are also presented by the marketer for browsing by a buyer);

Providing the buyer with a machine-readable signal for displaying the computed

price, ([0039], transmitting data for displaying the sale price of the good).

The following is obvious with Kopelman et al since settlements occur at a

clearinghouse, and prices need to be computed/determined in order to settle. Also,

since the title for the goods do not need to pass through the e-market when a buyer

directly goes through the manufacturer, the computed price would differ:

computing a price of the goods to the buyer based at least partially on the

determining act.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to compute a price of the goods to the buyer based at least

partially on the determining act with the motivation of determining the price according to

the method in which goods are accessed.

As for Claim 10, Kopelman et al further discloses the logic, wherein a first pricing

regime is implemented when it is determined that title to the goods passes directly from

the manufacturer to the buyer ([0040], escrow agent himself may itself act as the

intermediary, it is inherent that a first price regime will be implemented since the regime

is different than the regime used if the transaction went through an intermediary

clearinghouse, also see [0043], where the manufacturer/marketeer has goods of his

own for sale, it is inherent that a first price regime will be implemented since the regime

is different than the regime used if the transaction went through goods registered by

other sellers on the manufacturer's/marketeer's website).

As for Claim 11, Kopelman et al further discloses the computer, wherein when it

is determined that title passes through an intermediate e-market place, the method

further includes determining whether to implement the first pricing regime or a second

pricing regime ([0040], upon facilitating the sale transaction between the buyer and

seller, it can be done through referral to an intermediary clearinghouse, and is inherent

to determine which pricing regime should be implemented since the transaction can

also go through the escrow agent himself, which implements a different pricing regime,

also see [0043], where a sales transaction can also occur through the e-market, and in

this case, it is inherent to determine which pricing regime should be implemented since

the transaction can also go through the manufacturer/marketer himself, which

implements a different, or a second pricing regime).

As for Claim 12, Kopelman et al further discloses the logic programmable to

determine whether to discount a price, ([0028], lines 1-8, discount).

As for Claim 13, Kopelman et al further discloses the logic, wherein a discount is

determined based on volume of a current order ([0028], lines 6-11, discount is

determined based on whether book is used or paperback).

As for Claim 14, Kopelman et al does not specifically disclose the following:

further discloses the method, wherein a discount is determined based on: a

stocking/handling charge;

But does disclose that in retail type sales on online websites, an inventory of goods is maintained, and when maintaining inventory, it is common to include a stocking/handling charge in the inventory art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine a discount based in a stocking/handling charge with the motivation of allowing a reduced fee of an inventory of goods.

As for Claim 15, Kopelman et al further discloses the logic programmable to determine whether to customize the price ([0040], upon facilitating the sale transaction between the buyer and seller, the marketeer may refer the parties to an intermediary clearinghouse, or the escrow agent may itself act as the intermediary).

As for Claim 16, Kopelman et al further discloses the logic, wherein the price is customized based on: geographic region, customer information, product line information, *manufacturer information* ([0040], upon facilitating the sale transaction between the buyer and seller, the marketeer may refer the parties to an intermediary clearinghouse, or the escrow agent may itself act a s the intermediary).

As for Claim 17, Kopelman et al discloses a computer program product comprising:

computer readable code means for receiving the electronic price request from the buyer, ([0038]-[0039], buyer expresses interest in buying the good, for example clicking a checkbox on a web site, and the marketeer then presents the good at a sale price, in this case, since the price is unknown prior to the clicking of the box on the

website, and the price is presented afterwards, this "clicking" [by way of computer] represents the electronic price request);

computer readable code means responsive to receiving the electronic price request for determining whether title to the goods passes directly from the manufacturer to the buyer or through an intermediate e-market place, ([0040], upon facilitating the sale transaction between the buyer and seller, it can be done through referral to an intermediary clearinghouse, or the escrow agent himself may itself act as the intermediary, also see [0043], lines 1-4, shows that goods in addition to those listed or registered for sale by sellers at a marketeer's website in an e-market environment are also presented by the marketer for browsing by a buyer);

Computer readable code means for providing the buyer with a machine-readable signal for displaying the computed price, ([0039], transmitting data for displaying the sale price of the good).

The following is inherent with Kopelman et al since the system is directed towards electronic commerce applications, which are generally implemented on computerized systems, which need computer readable code to implement processing:

computer readable code

The following is obvious with Kopelman et al since settlements occur at a clearinghouse, and prices need to be computed/determined in order to settle. Also, since the title for the goods do not need to pass through the e-market when a buyer directly goes through the manufacturer, the computed price would differ:

computer readable code means for computing a price of the goods to the buyer

based at least partially on the determining;

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to compute a price of the goods to the buyer based at least partially on the determining act with the motivation of determining the price according to the method in which goods are accessed.

As for Claim 18, Kopelman et al further discloses the computer program product, wherein a first pricing regime is implemented when it is determined that title to the goods passes directly from the manufacturer to the buyer ([0040], escrow agent himself may itself act as the intermediary, it is inherent that a first price regime will be implemented since the regime is different than the regime used if the transaction went through an intermediary clearinghouse, also see [0043], where the manufacturer/marketeer has goods of his own for sale, it is inherent that a first price regime will be implemented since the regime is different than the regime used if the transaction went through goods registered by other sellers on the manufacturer's/marketeer's website).

As for Claim 19, Kopelman et al further discloses the computer program product, wherein when it is determined that title passes through an intermediate e-market place, the method further includes determining whether to implement the first pricing regime or a second pricing regime (([0040], upon facilitating the sale transaction between the buyer and seller, it can be done through referral to an intermediary clearinghouse, and is inherent to determine which pricing regime should be implemented since the transaction can also go through the escrow agent himself, which implements a different

pricing regime, also see [0043], where a sales transaction can also occur through the e-market, and in this case, it is inherent to determine which pricing regime should be implemented since the transaction can also go through the manufacturer/marketer himself, which implements a different, or a second pricing regime).

As for Claim 20, Kopelman et al further discloses the computer program product including the computer readable code means for determining whether to discount a price ([0028], lines 1-8, discount).

As for Claim 21, Walker et al. '636 further discloses the computer program product, wherein a discount is determined based on volume of a current order ([0028], lines 6-11, discount is determined based on whether book is used or paperback).

As for Claim 22, Kopelman et al does not specifically disclose the following:

further discloses the method, wherein a discount is determined based on: a stocking/handling charge;

But does disclose that in retail type sales on online websites, an inventory of goods is maintained, and when maintaining inventory, it is common to include a stocking/handling charge in the inventory art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine a discount based in a stocking/handling charge with the motivation of allowing a reduced fee of an inventory of goods.

As for Claim 23, Walker et al. '636 further discloses the computer program product including the computer readable code means for determining whether to customize the price, ([0040], upon facilitating the sale transaction between the buyer

and seller, the marketeer may refer the parties to an intermediary clearinghouse, or the escrow agent may itself act as the intermediary).

As for Claim 24, Walker et al. '636 further discloses the computer program product, wherein the price is customized based on: geographic region, customer information, product line information, *manufacturer information,* ([0040], upon facilitating the sale transaction between the buyer and seller, the marketeer may refer the parties to an intermediary clearinghouse, or the escrow agent may itself act a s the intermediary).

As for Claim 25, Walker et al. '636 discloses a data processing machine programmed to perform operations, the operations comprising:

receiving the request for quote/receiving from the buyer an electronic message comprising an RFQ, ([0038]-[0039], buyer expresses interest in buying the good, for example clicking a checkbox on a web site, and the marketeer then presents the good at a sale price, in this case, since the price is unknown prior to the clicking of the box on the website, and the price is presented afterwards, this "clicking" [by way of computer] represents the request for quote);

transmitting an electronic message representing a price of the goods to the buyer based at least partially on the determining step ([0039], transmitting data for displaying the sale price of the good).

The following is obvious with Kopelman et al since settlements occur at a clearinghouse, and prices need to be computed/determined in order to settle. Also,

since the title for the goods do not need to pass through the e-market when a buyer

directly goes through the manufacturer, the computed price would differ:

responsive to receiving the RFQ, determining a price of the goods based at least

partially upon a manufacturer's specification as to whether title to the goods will pass

directly from the manufacturer to the buyer or through an intermediate.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to determine the price of the goods to the buyer based at least

partially on the manufacturer's specification with the motivation of determining the price

according to the method in which goods are accessed.

Response to Arguments

5.   Applicant's arguments with respect to claims 1-25 have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Akiba K Robinson-Boyce whose telephone number is

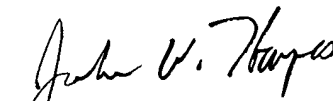571-272-6734. The examiner can normally be reached on Monday-Friday 9am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Hayes can be reached on 571-272-6708. The fax phone numbers for

the organization where this application or proceeding is assigned are 703-746-7238

[After final communications, labeled "Box AF"], 703-746-7239 [Official Communications],

and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

A. R. B.

November 27, 2006

JOHN W. HAYES

SUPERVISORY PATENT EXAMINER